

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

00-007

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on _____

Signature _____

Typed or printed name _____

Application Number

09/609,253

Filed

June 30, 2000

First Named Inventor

Jay S. Walker

Art Unit

3687

Examiner

FRENEL, Vanel

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

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assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

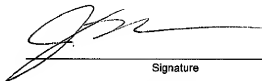
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attorney or agent of record. 55,106
Registration number _____

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

Jerome A. DeLuca

Typed or printed name

(203) 461-7319

Telephone number

September 2, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

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*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
CUSTOMER NO. 22927

Application No.: 09/609,253 **Appellants:** Walker et al. **Filed:** June 30, 2000

Title: METHODS AND APPARATUS FOR INCREASING AND/OR FOR MONITORING A PARTY'S COMPLIANCE WITH A SCHEDULE FOR TAKING MEDICINES

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Appellants respectfully request a Pre-Appeal Brief Conference to review the rejections set forth in the Office Action mailed April 2, 2009 (hereinafter, the "Present Office Action"). Appellants below demonstrate that after eight Office Actions and three previous successful Appeals, those references identified by the Office as most relevant still do not teach or suggest any of the pending claims.

Appellants accordingly request that the Conference allow all of the pending claims. Appellants also outline some clear errors in examination that must be corrected prior to any appeal of the present rejections. No amendments are being filed with this Request, and this Request is being filed concurrently with a Notice of Appeal.

Claims **2, 3, 5-47, 49, 50 and 116-125** are pending, and claims **2, 49 and 116** are the only independent claims.

Claims **49, 50 and 116-125** stand rejected under 35 U.S.C. §102(a) as being allegedly anticipated by U.S. Patent No. 5,950,632 to Reber et al. (hereinafter "Reber").

Claims **2, 3 and 5-47** stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Reber in view of U.S. Patent No. 6,529,446 to de la Hueraga et al. (hereinafter "de la Hueraga") and further in view of U.S. Patent No. 6,294,999 to Yarin et al. (hereinafter "Yarin").

Claims **2, 3, 5-47, 49, 50 and 116-125** stand rejected under 35 U.S.C. §101 as being allegedly drawn to non-statutory subject matter.

Claims **2, 3, 49 and 116** stand rejected on the ground of nonstatutory obviousness-type double patenting as being allegedly unpatentable over U.S. Patent No. 7,366,675 to Walker et al. ("Walker '675" hereinafter) in view of Yarin.

I. This Application Has Been in Condition for Allowance and/or Appeal for nearly Two Years, but has been Improperly Held up in Prosecution.

MPEP 707.02 requires PTO Supervisors to “impress their assistants with the fact that the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them.” It is not apparent to Appellants that this procedure has been followed here. Although “supervisory patent examiners are expected to personally check on the pendency of every application which is up for the third or subsequent Office action with a view to finally concluding its prosecution [and] [a]ny application that has been pending five years should be carefully studied by the supervisory patent examiner and every effort should be made to terminate its prosecution” (Id.), the present Office Action merely regurgitates the previously appealed art rejections verbatim while adding nominally “new” §101 and double patenting rejections that are baseless and easily disposed of below. Appellants have appealed substantially the same claims in view of the same art four times so far, and have yet to receive an Examiner’s Answer.

Applicants respectfully request allowance of all the pending claims, or else that the present appeal be allowed to proceed to the Board without reopening prosecution, sua sponte, by the Art Unit. If prosecution is reopened, Appellants reserve the right to appeal directly to the district court on the grounds that the PTO has unlawfully withheld and unreasonably delayed agency action. *See Thompson v. U.S. Dept. of Labor*, 813 F.2d 48, 52 (3rd Cir. 1987) (“The fact that the agency action is not ‘final’ does not alter this. The APA gives courts authority to review ongoing agency proceedings to ensure that they resolve the questions in issue within a reasonable time.”). Here, Appellants have been appealing essentially the same rejection for over two years. Appellants submit that reopening prosecution for any reason other than to allow the claims is not consistent with the swift disposition of this Application.

II. The Examiner Makes Contradictory Statements Regarding the Disposition of Applicants’ Previous Appeals of the Same Claims and Same Art.

This is the fourth appeal in this Application. In each of Applicants’ three prior appeals, the Examiner has reopened prosecution in lieu of presenting an Examiner’s Answer. The Present Office Action, in responding to Applicants’ most recent Appeal, filed on December 23, 2008, of the same §102 and §103 rejections of the same claims using the same art, states at page 2 that

“Applicant’s arguments filed on 12/23/08 have been persuasive, therefore the prior Office Action has been withdrawn and a new Office Action is hereby presented.”

However, the Office Action directly contradicts itself at page 17, stating that “Applicant’s arguments filed on 12/23/08 with respect to claims 2-3, 5-47, 49-50, and 116-125 have been considered but they are not persuasive.” The Office Action also, despite stating that prosecution has been reopened based on the persuasiveness of Applicants’ arguments, repeats the previously appealed §102 and §103 rejections verbatim.

Upon receiving the present Office Action, Applicant attempted to contact Examiner Frenel. When these attempts were unsuccessful, Applicant contacted Examiner Frenel’s Supervisor, Matthew Gart, who informed Applicant that he believed the “art didn’t show” all of Applicants’ limitations in light of Applicants’ Appeal Brief, and that he had instructed Examiner Frenel to “find new art.” Instead, the Office Action contains the same art rejections, reproduced verbatim from the previous appealed Office Action, as well as non-supportable §101 and double patenting rejections (discussed in detail below).

After numerous further attempts to contact Examiner Frenel, Applicants finally succeeded in scheduling an interview on May 14, 2009, to discuss how to best expedite prosecution, but in that interview, Examiner Frenel was unable to explain his contradictory statements. Examiner Frenel did state that Claim 20 would be allowable if rewritten in independent form, but Examiner Frenel could not point to any other art that rendered any other claim unpatentable. Applicants asked Examiner Frenel whether he could promise that a fourth Appeal of these rejections would receive an Examiner’s Answer, and Examiner Frenel promised that it would.

III. None of Reber, de la Hueraga or Yarin Teaches or Suggests Communications Between Two Medicine Containers

Appellants respectfully submit that identical rejections were disposed of in Appellants' previous appeal, and need not be repeated here. Complete arguments in response to the outstanding §102 and §103 rejections can be found in Appellants' previous Appeal Brief filed December 23, 2008..

IV. The Newly Added §101 Rejection is Baseless

All of the pending claims recite statutory subject matter. In fact, independent claim 49 is an apparatus claim that recites, *inter alia*, "a medicine container." Additionally, the independent method claims all recite corresponding structure. Claim 2 recites, *inter alia*, "storing information," "wirelessly communicating a signal between a first container . . . and a second container" and "generating at least one code based at least in part on the signal." Independent claim 116 likewise recites, *inter alia*, "obtaining a first container" and "storing a first medicine in the first container."

When Appellants pointed out these features to Examiner Frenel in the May 14 interview, the Examiner was unable to set forth the basis for the rejection.

V. The Newly Added Double Patenting Rejection Does Not Present a Prima Facie Case of Obviousness.

Claims 1, 8 and 9 of Walker '675 are directed to, *inter alia*, "determining whether a first container for storing a first medicine was positioned so as to wirelessly communicate with a second container."

The cited claims, alone or in combination with Yarin, do not recite "an indication of a number of times that the second container is beyond a range in which the first container is able to communicate with the second container" as recited by Claim 2 of the present application, "transmitting information regarding the first medicine" as recited by Claim 3, "a medicine storage region" as recited by Claim 49, or "storing a first medicine in the first container" as recited by claim 116.

VI. Conclusion

Appellants respectfully request review and reversal of all of the pending rejections.

Respectfully submitted,

September 2, 2009

Date

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